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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,061	01/02/2002	Boas Betzler	POU901066US1	9115

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HESLIN ROTHENBERG FARLEY & MESITI P.C.  
5 COLUMBIA CIRCLE  
ALBANY, NY 12203

EXAMINER

SCUDERI, PHILIP S

ART UNIT PAPER NUMBER

2153

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/039,061

Applicant(s)

BETZLER, BOAS

Examiner

Philip S. Scuderi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-8,10,11,15-18,20-22 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8,10,11,15-18,20-22 and 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This Office action is in response to applicant's amendment filed on 12 January 2006.

### *Response to Arguments*

Applicant's arguments that U.S. Patent No. 5,995,500 to Ma et al. does not teach various amended limitations have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, the claims remain too broad for allowance.

The claims read on establishing a direct connection between two instant messaging clients. The specification defines a piconet as "any wireless network with direct peer-to-peer capabilities" (0023). According to this definition a piconet reads on any network with at least one wireless connection that enables clients to establish direct connections to each other. As such, a new ground(s) of rejection is made below.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 7, 8, 10, 11, 16-18, 20-22, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2003/0112823 to Collins et al. ("Collins").

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Regarding claims 1, 7, 8, 10, 16-18, 20, 21, 27, and 28, Collins teaches a method of establishing instant messaging communication between devices (figure 4a), said method comprising:

connecting a first device to an instant messaging server (0039, connecting PC 112 to rendezvous service 400; 0037, MSN Messenger is an example of a rendezvous service);

transmitting device address and access code information of the first device from the first device to the instant messaging server (0039, PC 112 must transmit address and access code information to the rendezvous service 400 because otherwise PC 100 would not be able to attempt to establish a direct connection to PC 112 upon receiving an invitation);

requesting by the first device a list of active devices from the instant messaging server (0039, PC 112 must have received a list of devices from rendezvous service 400 in order to select to invite PC 100);

transferring from the instant messaging server to the first device the list of active devices (0039, PC 112 must have received a list of devices from rendezvous service 400 in order to select to invite PC 100);

employing by the first device the list of active devices to identify at the first device at least one additional device (0039, identifying PC 100); and

responsive to said employing, establishing by the first device direct instant messaging communication between the first device and a second device without further employing the instant messaging server, and wherein the direct instant messaging between the first device and the second device is direct communication therebetween (0039, establishing direct connection 406, "Note the importance of the directness of communications flow 406; it does not pass through the rendezvous service.").

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In figure 3 Collins shows a detailed examples of PCs 100/112 (0035). Collins further teaches that the PCs may connect via wireless media (0035). As such, PCs 110/112 can be considered wireless devices, the direct connection between the PCs (406) can be considered a direct wireless connection, and the PCs can be considered in to be in the same piconet according to applicant's definition of a piconet.

Regarding claims 2, 11, and 22, Collins teaches that the establishing comprises transitioning from client/server based communication with the instant messaging server to wireless peer-to-peer communication without the need for the instant messaging server therebetween (0039, establishing direct connection 406, "Note the importance of the directness of communications flow 406; it does not pass through the rendezvous service.").

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 15, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins.

Collins cites MSN Messenger as an example of the instant messaging protocol (0037), but does not expressly disclose use of the Jabber protocol. Nonetheless, it would have been obvious to one of ordinary skill in the art to use the Jabber protocol for any of the well-known advantages that

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the Jabber protocol provides (e.g., decentralized architecture, the ability to build custom functionality, etc.).

Collins cites RF and infrared as examples of the wireless standards used to connect the PCs (0035). However, Collins does not expressly disclose use of the Bluetooth standard. Nonetheless, it would have been obvious to one of ordinary skill in the art to use the Bluetooth standard for any of the well-known advantages that Bluetooth provides (e.g., low cost, low power, etc.).

The examiner takes official notice that the Jabber and Bluetooth protocols provide well-known advantages such as the examples given above.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

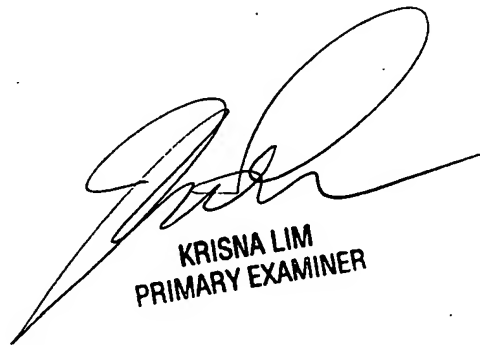
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSS



KRISNA LIM  
PRIMARY EXAMINER